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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/510,087 02/22/00 SMITH

P EVS-P-99-017

QM02/1207

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EXAMINER

WALCZAK, D

ART UNIT

PAPER NUMBER

3751

DATE MAILED:

12/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/510,087

Applicant(s)
Smith

Examiner
David Walczak

Group Art Unit
3751



☒ Responsive to communication(s) filed on Nov 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) 12, 13, and 20 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 14-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election of Species

1. Applicant's election without traverse of Species II in Paper No. 3 is acknowledged.
Claims 1-11 and 14-19 are readable thereon and, accordingly, will be examined herein.

Abstract

2. The abstract of the disclosure is objected to because phrases which can be implied, such as "are provided" (see line 2) should not be present therein. Correction is required. See MPEP § 608.01(b).

Specification

3. The disclosure is objected to because of the following informalities: On page 9, line 27, "largerg13" should be --larger-- and there should be no paragraph break at this point.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It

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is unclear as to how the tool attaches the clamps to the article, i.e., the specification does not disclose how tool 68 engages the clamps in order to enable them to be tightened.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. An antecedent basis for "the clamps" should be defined (currently, only one clamp has been defined in claim 10).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer.

In regard to claims 9 and 10, Fischer discloses a "device accessory kit" comprised of a marking device, a flat article which wraps around the marking device and a "clamp" (the stitching) which clamps the article to the marking device. In regard to claim 14, there must exist some "tool" which attaches the stitching to the article.

8. Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al. (hereinafter Martin). Martin discloses an accessory kit comprised of marking device 16, an end

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cap 15 which is capable of fitting onto the end of a plurality of marking devices (lines 82-85) and a chain 14 connected to the end cap.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-8, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin. In regard to claims 1-4 and 6-8, as discussed supra, Fischer discloses a marking device covered with a sheath. Although Fischer does not disclose the use of an end cap, attention is directed to the Martin reference which, as discussed supra, discloses an end cap for a marking instrument as claimed in order to enable the marking instrument to be secured to a particular location. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such an end cap onto the Fischer device in order to enable the device to be secured to a particular location. In regard to claims 17 and 19, the method as claimed is inherent in the usage of the device defined supra.

11. Claims 5 and 18 are U.S.C. 103(a) as being unpatentable over Fischer in view of Martin as applied to claims 1 and 17 above, and further in view of the Applicant's disclosure. Although the sheath in the Fisher reference is not disclosed as having an antibacterial substance thereon,

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attention is directed to page 7, lines 17 of the Applicant's disclosure, which discloses that anti-bacterial substances are commonly used to coat surfaces in order to render the surfaces sanitary (column 2, lines 66-67). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the sheath in the Fischer device with an anti-bacterial coating in order to render the sheath sanitary.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of the Applicant's disclosure. As discussed supra, it would have been obvious to coat the Fischer sheath with an anti-bacterial coating.


Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Lorber, Richie, Holywell and Glaesser references are cited for disclosing other writing implement holders.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Walczak whose telephone number is (703) 308-0608.

D Walczak

December 5, 2000


DAVID J. WALCZAK
PRIMARY EXAMINER